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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,035	07/27/2001	Thomas Falone		6238

7590 01/23/2002

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 01/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/917,035

Applicant(s)

FALONE ET AL.

Examiner

Stephen L. Blau

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 35-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 43-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 July 2001 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- a. Species 1 (Around gripping area): Claims 1-34 and 43-46.
- b. Species 2 (Within hollow shaft): Claims 35-39.
- c. Species 3 (Athletic Pads): Claims 40-42.

A restriction is required. In accordance to article 1450 (MPEP), the original patent claims 1-27 of the vibration absorbing material being around the gripping area will be held to be constructively elected. As such claims 28-34 and 43-46 also directed to the vibration absorbing material being around the gripping area will be considered elected and claims 35-42 will be held as being constructively non-elected and withdrawn from consideration. Claims 1-34 and 43-46 are treated on the merits below. A phone call requiring an election was not required.

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Reissue Applications***

3. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Response to Amendment***

4. The amendment filed with Reissue Application dated 27 July 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In insert after line 27 of column 5 in lines 22-23 the putters and shoulder pads are considered new matter having never been previously disclosed in applications 08/868,357 and 08/560,699.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Specification***

5. The specification and claims are objected to under 37 CFR 1.173 (a) (1) for not being in "double column format". The application was filed in "single column format".

✓

The applicant is required to submit the specification and original patent claims as a clean copy in double column format, together with a preliminary amendment directed to the amendments to the specification and claims that were filed with the case. These amendments must comply with 37 CFR 1.173(b)(1) and 1.173(b)(2), respectively.

Appropriate correction is required.

### ***Drawings***

6. The drawings are objected to under 37 CFR 1.173(b)(3) due to newly submitted figure 20 isn't labeled "new". A new proposed figure 20 properly labeled is required.

### ***Oath/Declaration***

7. The reissue oath/declaration filed with this application is defective because it fails to identify **in a positive statement** that there is at least one error which is relied upon to support the reissue application. The declaration talks about "alleged errors" and that the patent "may be" inoperative. See 37 CFR 1.175(a)(1) and MPEP § 1414.

8. Claims 1-34 and 43-46 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion in paragraph 6 above in this Office action.

### ***Claim Objections***

9. Claims 28-34 and 43-46 are objected to under article 1412.02 (MPEP) since these reissue claims relate to subject matter that applicant previously surrendered during the prosecution of the original application. Specifically the subject matter surrendered is a continuous series of peaks and valleys, the thickness of the vibration absorbing material at the valley being greater than twice the thickness of the vibration absorbing material at the peaks, the outer ends of the peaks being closer to an outer surface than any other portions of the inner core is to the outer surface, and the projections extending into the vibration absorbing material a substantial distance. See Office Action dated 10 August 1998 paragraphs 8-10, interview summary dated 26 October 1998 (Paper No. 8), and amendment dated 7 December 1998 (Paper No. 10) lines 1-6, and 20-24 on page 6 through line 4 page 7.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 28, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell.

Pennell discloses a hand held article in the form of a tennis racket (Title), a flexible vibration absorbing material being tacky and soft and having a hardness of 20, Shore A hardness, a vibration absorbing material having a high dampening of vibration in the form of being a soft rubber (Col. 2, Lns. 11-20), a tape (Col. 1, Lns. 48-59), and outer surface of the vibration absorbing material being the sole user during use of the article (Fig. 3). Clearly the outer grip material of Pennell will have a specific softness to provide comfort to a golfer's hand when impacting a ball and a coefficient of friction to prevent a golfer's hand from slipping on a grip when swinging a club in which a hardness less than about 40 durometer Class D durometer reading and a vibration material having a high coefficient of friction are included.

Pennell lacks a vibration absorbing material having a hardness less than about 40 durometer Class D durometer reading and a vibration material having a high coefficient of friction. It would have been obvious to modify the vibration absorbing material of Pennell to have a hardness less than about 40 durometer Class D durometer reading in order to provide sufficient softness to a player's hand to minimize the vibrations felt when impacting a ball. In addition, it would have been obvious to modify the vibration absorbing material of Pennell to have vibration material having a high coefficient of friction in order to prevent a player's hand from slipping.

12. Claims 29, 31 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell as applied to claims 28, 30 and 32 above, and further in view of Davis.

Pennell lacks a vibration absorbing material being applied to a mesh material and a vibration absorbing material being silicon. Davis discloses a grip in which a mesh structure is applied to a grip and then impregnated by an silicone material (Col. 3, Lns. 41-51, Col. 2, Lns. 22-26) because its characteristics include softness, high tensile strength, high elongation, and abrasion resistance (Col. 2, Lns. 11-21). In view of the patent of Davis it would have been obvious to have a vibration absorbing material being applied to a mesh material and a vibration absorbing material being silicone in order to have a grip with the characteristics including softness, high tensile strength, high elongation, and abrasion resistance.

13. Claims 43 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell in view of Avetoom.

Pennell discloses an inner core around (Ref. No. 17, Figs. 2-3).

Pennell lacks an inner core tapering in diameter from one end to another. Avetoom discloses a grip being tapered from one end to another end (Fig. 2). In view of the patent of Avetoom it would have been obvious to have a grip tapering from one end to another end in order to fit onto a shaft which is tapered from one end to another.

See elements of structure previously rejected by Davis.



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14. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell as applied to claims 43 and 46 above, and further in view of Davis.

Pennell lacks a dampening of vibration being greater than 55%, a vibration absorbing material being silicon, and a coefficient of friction being .6-1.0. Davis discloses a grip in which a mesh structure is applied to a grip and then impregnated by an silicone material (Col. 3, Lns. 41-51, Col. 2, Lns. 22-26) because its characteristics include softness, high tensile strength, high elongation, and abrasion resistance (Col. 2, Lns. 11-21). Davis does not specifically state the coefficient of friction and dampening of vibration but clearly a grip with have these characteristics and an artisan skilled in the art of designing a grip which will not slip out of a golfer's hand and protect a golfer from vibrations when impacting a ball would have selected suitable characteristics for a grip in which a dampening of vibration being greater than 55% and a coefficient of friction being .6-1.0 are included. In view of the patent of Davis it would have been obvious to modify the grip of Pennell to have a vibration absorbing material being silicone in order to have a grip with the characteristics including softness, high tensile strength, high elongation, and abrasion resistance. In addition, in view of the patent of Davis it would have been obvious to modify the grip of Pennell to have a dampening of vibration being greater than 55% in order to protect a golfer from damaging ones hands due to vibrations when impacting a ball. Finally, in view of the patent of Davis it would have been obvious to modify the grip of Pennell to have a coefficient of friction being .6-1.0 in order to prevent the grip from slipping out of a golfer's hand when playing a round of golf.

15. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pennell as applied to claims 43 and 26 above, and further in view of Davis and Kobayashi.

Pennell lacks a vibration absorbing material being non-porous. Kobayashi discloses a gripping material being non-porous in order to reduce the wear of a surface of a grip (Col. 1, Lns. 34-39). In view of the patent of Kobayashi it would have been obvious to modify the grip of Pennell to have the vibration absorbing material being non-porous in order to reduce the wear of an outer material of a grip.

See paragraph 12 above for elements of structure previously rejected by Pennell in view of Davis.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (703) 308-2712. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Paul Sewell whose telephone number is (703) 308-2126. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.



Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700

Slb  
1/16/02  
